

REMARKS

Reconsideration of the application is respectfully requested. Claims 1-34 are pending and at issue.

The Examiner has required election in this application among the claims of:

- Group I: Claim 5 (and claims 1-5, 7-20, and 24-31 when one of X is N), drawn to pyridinyl piperidines;
- Group II: Claims 6 and 21-23 (and claims 1-5, 7-20, and 24-31 when each X is CR₁), drawn to phenyl piperidines;
- Group III: Claim 32, drawn to a method of treating particular affective disorders;
- Group IV: Claim 33, drawn to a method of treating particular urinary disorders; and
- Group V: Claim 34, a method of treating particular eating disorders.

In order to be fully responsive, applicants provisionally elect the claims of Group II (claims 6 and 21-23 (and claims 1-5, 7-20, and 24-31 when each X is CR₁), and the species *N*-(4-fluoro-3-(4-piperidyl)phenyl)-5-(4-phenylphenyl)pentanamide for further prosecution. However, applicants respectfully traverse this restriction requirement and request: (i) that claims 7-20 and 24-26 be fully examined together with the claims of Group II, and (ii) rejoinder of the claims of Groups III, IV, and V with the claims of Group II.

Group II includes claim 6, which is directed to compounds having the formula shown in claim 1 wherein each X is CR₁. Claims 7-20 and 24-26 depend from claim 6, either directly or through intervening claims. All of these claims are directed to compounds having the formula shown in claim 1 wherein each X is CR₁. Accordingly, claims 7-20 and 24-26 are not generic

claims and do not fall within Group I. Therefore, claims 7-20 and 24-26 should be fully examined together with the claims of Group II.

Furthermore, when the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even if it includes claims to independent or distinct inventions. MPEP § 803. The present restriction requirement is hereby traversed on the grounds that it would not place a serious burden on the Examiner to search the claims of Group II together with the claims of Groups III, IV, and V, to the extent that the claims of Groups III, IV, and V read on the claims of Group II.

The claims of Groups III, IV, and V (i.e., claims 32, 33, and 34, respectively) are drawn to methods of treatment comprising administration of a compound of claim 1. Although these claims may be patentably distinct from the claims of Group II, a search for prior art related to the compounds recited in the claims of Group II would be co-extensive with a search for prior art related to the methods recited in the claims of Groups III, IV, and V (to the extent that the method claims read on the claims of Group II) because, for example, both searches would be based on the same chemical formula and would thus involve searches of the same classes and subclasses. Furthermore, if the compounds recited in the claims of Group II are patentable over the prior art, then so are the methods recited in the claims of Groups III, IV, and V (to the extent that the method claims read on the claims of Group II), because the methods require the administration of the compounds covered by the claims of Group II. Accordingly, applicants respectfully request that the claims of Group II be examined together with the claims of Groups III, IV, and V (to the extent that the method claims read on the claims of Group II).

An early and favorable action on the merits of the application is courteously solicited.

No fee is believed to be due with this submission. If, however, any fee is due, the Commissioner is authorized to charge it up to \$2,000.00 to Deposit Account No. 04-0100.

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Respectfully submitted,

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